

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1, 2 and 8 are rejected under 35 U.S.C. 103(a) over the patent to Odendahl.

Also, the drawings and the abstract are objected to and the claims are rejected under 35 U.S.C. 112.

After carefully considering the Examiner's grounds for formal objections and rejections, applicants have amended the specification as required, provided a replacement sheet of Figure 1 with the corrections, provided a new abstract of the disclosure, and amended claims 1 and 2.

It is believed that the Examiner's grounds for formal objections and rejections are therefore eliminated.

It is respectfully submitted that claims 1 and 2 clearly and patentably distinguish the present invention from the prior art applied by the Examiner against the original claims.

Before the analysis of the prior art it is believed to be advisable to explain to the Examiner the new features of the present invention as defined in claims 1 and 8.

Claims 1 and 8 define a power compass saw with a housing accommodating a lifting rod for up and down movements of longitudinal saw blade having a toothed side and a saw blade back, and with a guide roller which serves as a reciprocating stroke-support roller, supports the saw blade back, and has a central circumferential groove into which the saw blade extends with its saw blade back and is guided therein.

The patent to Odendahl discloses a saw with a housing, a lifting rod, a blade having a toothed side and an opposite saw blade back, a guide roller 122, etc. In the saw disclosed in the reference the guiding sword 30, 130 has a groove which receives the saw blade back and extends along almost the whole length of the saw blade back to reciprocatingly support the latters. Figure 3, in contrast to the Examiner's opinion, does not disclose a roller with a groove for receiving the saw blade back, but it shows a cross-section of the sword which has the central groove that receives the saw blade back and guides the latter.

It is believed to be clear that the patent to Odendahl does not teach the new features of the present invention which are now defined in claims 1 and 2.

The original claims were rejected over the patent to Odendahl under 35 U.S.C. 103 as being obvious. It is believed that it is clear that this reference does not teach the new features of the present invention and it does not contain any hint or suggestion for such features. In order to arrive at the applicant's invention from the teaching of the reference the reference has to be fundamentally modified by including into it the new features of the present invention which are now defined in claims 1 and 2.

However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a

reference to modify its structure to one which prior art references do not suggest.

The present invention as defined in the current claims provide for the highly advantageous results. When the guiding roller has a groove in which the saw blade back is received, first of all the guiding roller is significantly shorter than the sort of the patent to Odendahl, it has a substantially point contact instead of a line or surface contact, and it has lower friction with the saw blade back.

It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushima and Takahashi (174 USPQ 38), as follows:


Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claims 1 and 2 should be considered as patentably distinguishing over the art and should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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